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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,331	08/23/2006	Sabine Losch	31608-230512	8343
26694	7590	01/14/2008		
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			EXAMINER GREEN, ANTHONY J	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 01/14/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/590,331

**Applicant(s)**

LOSCH ET AL.

**Examiner**

Anthony J. Green

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007 and 27 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 7 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. This office action is in response to the amendment submitted on 05 October 2007 and 27 November 2007. Claims 1-5 have been canceled and new claims 6-10 have been added. Currently claims 6-10 are currently pending.

### *Response to Arguments Concerning Non-Responsive Amendment*

2. Applicant argues that Rule 1.121 does not relate to abstracts nor to the addition of new pages. Applicants further argue that the US PTO did not comply with Section 714.IIF of the MPEP with respect to factual support for non-entry of claims and that by way of illustration, it is not clear what changes, if any, were in fact required by the USPTO.

To these arguments the examiner offers the following comments:

According to **MPEP 714 [R-6] II** if an amendment is not in compliance with 37 CFR 1.121 the applicant should be notified of the fact that the amendment submitted was not proper by the sending out of a Notice Of Non-Compliant Amendment. The examiner has bolded the important points which pertain to the Notice that was previously sent to applicant. Accordingly, contrary to applicant's assertion, the Notice of Non-Compliant Amendment that was previously sent to application was indeed proper as applicant should note that applicant, in the amendment of 05 October 2007, submitted an abstract containing underlining and did not show all of the changes made

to claim 5 relative to the previous version (i.e. note the addition of the term "further" which was not underlined).

A copy of MPEP 714 [R-6] II appears below for applicants convenience. The examiner has bolding the important points which pertain to the Notice that was previously sent to applicant:

## **II. MANNER OF MAKING AMENDMENTS UNDER 37 CFR 1.121**

**All amendments filed on or after July 30, 2003 must comply with 37 CFR 1.121 as revised in the notice of final rule making published in the Federal Register on June 30, 2003 at 65 Fed. Reg. 38611. The manner of making amendments has been revised to assist in the implementation of beginning-to-end electronic image processing of patent applications. Specifically, changes have been made to facilitate electronic image data capture and processing and streamline the patent application process. If an amendment filed on or after July 30, 2003 does not comply with revised 37 CFR 1.121, the Office will notify applicants via a Notice of Non-Compliant Amendment that the amendment is not accepted.**

The revised amendment practice is summarized as follows.

### **A. Amendment Sections**

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet to facilitate separate indexing and electronic scanning of each section of an amendment document for placement in an image file wrapper.

It is recommended that applicants use the following format when submitting amendment

papers. The amendment papers should include, in the following order:

- (A) a cover sheet, or introductory comments, providing the appropriate application information (e.g., application number, applicant, filing date) and which serves as a table of contents to the amendment document by indicating on what page of the amendment document each of the following sections begin;
- (B) a section (must begin on a separate sheet) entitled "Amendments to the Specification" (if there are any amendments to the specification). This section should include all amendments to the specification including amendments to the abstract of the disclosure;
- (C) a section (must begin on a separate sheet) entitled "Amendments to the Claims" which includes a complete listing of all claims ever presented in the application (if there are any amendments to the claims);
- (D) a section (must begin on a separate sheet) entitled "Amendments to the Drawings" in which all changes to the drawings are discussed (if there are any amendments to the drawings);
- (E) a remarks section (must begin on a separate sheet); and
- (F) any drawings being submitted including any "Replacement Sheet," "New Sheet," or "Annotated Sheet."

#### **B. Amendments to the Specification**

Amendments to the specification, other than the claims, computer listings (37 CFR 1.96) and sequence listings (37 CFR 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification. In order to delete,

replace or add a paragraph to the specification of an application, the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § 608.01), page and line, or any other unambiguous method and be accompanied by any replacement or new paragraph(s). Replacement paragraphs must include markings to show the changes. A separate clean version of any replacement paragraphs is not required. **Any new paragraphs must be presented in clean form without any markings (i.e., underlining).**

Where paragraph numbering has been included in an application as provided in 37 CFR 1.52(b)(6), applicants can easily refer to a specific paragraph by number when presenting an amendment. If a numbered paragraph is to be replaced by a single paragraph, the added replacement paragraph should be numbered with the same number of the paragraph being replaced. Where more than one paragraph is to replace a single original paragraph, the added paragraphs should be numbered using the number of the original paragraph for the first replacement paragraph, followed by increasing decimal numbers for the second and subsequent added paragraphs, e.g., original paragraph [0071] has been replaced with paragraphs [0071], [0071.1], and [0071.2]. If a numbered paragraph is deleted, the numbering of the subsequent paragraphs should remain unchanged. 37 CFR 1.121(b)(1)(ii) requires that the full text of any replacement paragraph be provided with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after

the deleted characters may be used to show the deletion of five or fewer consecutive characters (e.g., ~~[[error]]~~). The term "brackets" set forth in 37 CFR 1.121 means square brackets – [ ], and not parentheses – ( ). The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived (e.g., deletion of the number "4" must be shown as ~~[[4]]~~). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g., ~~\_\_\_\_\_ number 4 as number 14 as~~). For added paragraphs, 37 CFR 1.121(b)(3)(iii) requires that the full text of any added paragraph(s) be presented in clean form without any underlining. Similarly, under 37 CFR 1.121(b)(3)(iv), a marked up version does not have to be supplied for any deleted paragraph(s). It is sufficient to merely indicate or identify any paragraph that has been deleted. The instruction to delete may identify a paragraph by its paragraph number, page and line number, or include a few words from the beginning, and end, or the paragraph, if needed for paragraph identification. Applicants are also permitted to amend the specification by replacement sections (e.g., as provided in 37 CFR 1.77(b), 1.154(b), or 1.163(c)). As with replacement paragraphs, the amended version of a replacement section is required to be provided with markings to show all the changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show the deletion of five or fewer consecutive

characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived, Applicants are also permitted to amend the specification by submitting a substitute specification, provided the requirements of 37 CFR 1.125(b) and (c) are met. Under 37 CFR 1.125, a clean version of the substitute specification, a separate marked up version showing the changes in the specification relative to the previous version, and a statement that the substitute specification contains no new matter are required.

Any previously deleted paragraph or section can only be reinstated by a subsequent amendment presenting the previously deleted subject matter. A direction by applicant to remove a previously entered amendment will not be permitted.

### **C. Amendments to the Claims**

Each amendment document that includes a change to an existing claim, including the deletion of an existing claim, or submission of a new claim, must include a complete listing of all claims ever presented (including previously canceled and non-entered claims) in the application. After each claim number, the status identifier of the claim must be presented in a parenthetical expression, and the text of each claim under examination as well as all withdrawn claims **(each with markings if any, to show current changes) must be presented.**

The listing will serve to replace all prior versions of the claims in the application.

(A) Status Identifiers: The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the



following status identifiers: (original), (currently amended), (previously presented), (canceled), (withdrawn), (new), or (not entered). The status identifier (withdrawn – currently amended) is also acceptable for a withdrawn claim that is being currently amended. See paragraph (E) below for acceptable alternative status identifiers.

Claims added by a preliminary amendment must have the status identifier (new) instead of (original), even when the preliminary amendment is present on the filing date of the application and such claim is treated as part of the original disclosure. If applicant files a subsequent amendment, applicant must use the status identifier (previously presented) if the claims are not being amended, or (currently amended) if the claims are being amended, in the subsequent amendment. Claims that are canceled by a preliminary amendment that is present on the filing date of the application are required to be listed and must have the status identifier (canceled) in the preliminary amendment and in any subsequent amendment.

The status identifier (not entered) is used for claims that were previously proposed in an amendment (e.g., after-final) that was denied entry.

> In an amendment submitted in a U.S. national stage application, claims that were present on the international filing date or rectified pursuant to PCT Rule 91 must have the status identifier (original); claims that were amended or added under PCT Article 19 or 34 with effect in the U.S. national stage application must have the status identifier (previously presented); and claims that were canceled pursuant to

PCT Article 19 or 34 with effect in the U.S. national stage application must have the status identifier (canceled). If the amendment submitted in the U.S. national stage application is making a change in a claim, the status identifier (currently amended) must be used for that claim.<

For any amendment being filed in response to a restriction or election of species requirement and any subsequent amendment, any claims which are non-elected must have the status identifier (withdrawn). Any non-elected claims which are being amended must have either the status identifier (withdrawn) or (withdrawn – currently amended) and the text of the non-elected claims must be presented with markings to indicate the changes. Any non-elected claims that are being canceled must have the status identifier (canceled).

**(B) Markings to Show the Changes: All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by strike-through (for deleted matter) or underlining (for added matter) with 2 exceptions: (1) for deletion of five or fewer consecutive characters, double brackets may be used (e.g., [[error]]); (2) if strike-through cannot be easily perceived (e.g., deletion of number “4” or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text**

**with the desired change (e.g., \_\_\_\_\_ number 4 as number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status “currently amended” or “withdrawn” will include markings. Any claims added by amendment must be indicated as “new” and the text of the claim must not be underlined.**

(C) Claim Text: The text of all pending claims under examination and withdrawn claims must be submitted each time any claim is amended. The text of pending claims not being currently amended, including withdrawn claims, must be presented in clean version, i.e., without any markings. Any claim presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims. A claim being canceled must be indicated as “canceled;” the text of the claim must not be presented. Providing an instruction to cancel is optional. Canceled and not entered claims must be listed by only the claim number and status identifier, without presenting the text of the claims. When applicant submits the text of canceled or not-entered claims in the amendment, the Office may accept such an amendment, if the amendment otherwise complies with 37 CFR 1.121, instead of sending out a notice of non-compliant amendment to reduce the processing time.

(D) Claim Numbering: All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or not entered claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

A canceled claim can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. For example, when applicant cancels all of the claims in the original specification and adds a new set of claims, the claim listing must include all of the canceled claims with the status identifier (canceled) (the canceled claims may be aggregated into one statement). The new claims must be numbered consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not) in compliance with 37 CFR 1.126.

Example of listing of claims:

Claims 1-5 (canceled)

Claim 6 (withdrawn): A process for molding a bucket.

Claim 7 (previously presented): A bucket with a handle.

Claim 8 (currently amended): A bucket with a \_\_\_\_\_ green blue handle.

Claim 9 (withdrawn): The process for molding a bucket of claim 6 using molten plastic material.

Claim 10 (original): The bucket of claim 8 with a wooden handle.

Claim 11 (canceled)

Claim 12 (previously presented): A bucket having a circumferential upper lip.

Claim 13 (not entered)

Claim 14 (new): A bucket with plastic sides and bottom.

(E) Acceptable Alternative Status Identifiers : To prevent delays in prosecution, the Office will waive certain provisions of 37 CFR 1.121 and accept alternative status identifiers not specifically set forth in 37 CFR 1.121(c). See Acceptance of Certain Non-Compliant Amendments Under 37 CFR 1.121(c), O.G. (July 5, 2005). Accordingly claim listings that include alternative status identifiers as set forth below may be accepted if the amendment otherwise complies with 37 CFR 1.121.

Applicant should also refer to the office flyer concerning revised amendments that was previously mailed to all applicants, a copies of which may be found at the following website addresses wherein there is provided guidance as to the submission of proper amendments:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/moreinfoamdtprac.htm>

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knauf et al (US Patent No. 3,770,468 A) for the reasons set forth in the previous office action and which are herein incorporated by reference. Please note that

previously claim 1 and 3-5 were rejected however these claims were replaced with new claims 6 and 8-10.

Applicant argues that the instant claims are not rendered obvious by the reference as the reference teaches the use of citric acid the structure of which differs from the tartaric acid of the instant claims and since tartaric acid and citric acid are different "carboxylic acids" they are not identical in their efficacy. Applicant also argues in the 4<sup>th</sup> paragraph of page 11 of the response that: "A significant difference between D1 and applicants' additive is the use of the compound sodium tri metaphosphate which is a slowly soluble phosphate type containing cyclic phosphates". Applicant also argues in the last sentence of page 12 that the reference "is silent to the control or prolongation of the end point of the setting process and even it is using a very different mixture for a completely different reason".

To these arguments the examiner respectfully disagrees. As for the use of tartaric acid while the reference does not specifically recite the use of tartaric acid it does teach that "carboxylic acids with at least four carbon atoms and at least one hydroxyl group" may be utilized and accordingly since tartaric acid would meet this type of carboxylic acid its use is obvious absent evidence showing otherwise. As stated previously: "A reference can be used for all it realistically teaches and is not limited to the disclosures in its specific examples". See *In re Van Marter et al* 144 USPQ 421; *In re Windmer et al* 147 USPQ 518, 523; and *In re Chapman et al* 148 USPQ 71. As for applicant's argument concerning the use of the compound sodium trimetaphosphate the reference teaches in column 1, lines 63+ that sodium trimetaphosphate may be utilized

and accordingly it is unclear as to what applicant means by the argument that the significant difference between the reference and applicant's additive is the use of sodium trimetaphosphate since this compound is specifically taught by the reference. Applicant argument found in the last sentence of page 12 is not completely understood as this argument does not appear to be commensurate in scope with what is recited in the instant claims and further the reference teaches that the phosphate and the carboxylic acid may be used as set retarders.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is confusing as it refers to the composition of claim 6 however claim 6 is not a composition claim but rather a method claim.

***Claim Objections***

7. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

It is not clear as to how claim 10 further limits claim 6 when claim 6 is a method claim. It is not proper to select a single feature from a claim as a dependent claim, by default, contains all of the limitations of the parent claim and claim 1 is drawn to a method of retarding it is not specifically drawn to a composition.

***Allowable Subject Matter***

8. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



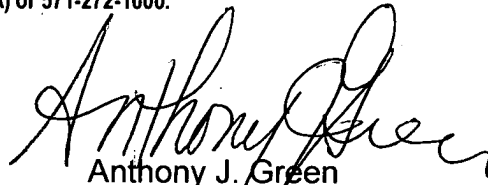
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony J. Green  
Primary Examiner  
Art Unit 1793

ajg  
January 8, 2008